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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,964	07/03/2003	Mark Vaughn	100202889-1	6789

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EXAMINER

OBEID, FAHD A

ART UNIT	PAPER NUMBER
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3627

NOTIFICATION DATE	DELIVERY MODE
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03/03/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/613,964	Applicant(s) VAUGHN, MARK	
	Examiner FAHD A. OBEID	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. This is in reply to communication filed on 12/16/2009.
2. No claims have been added or cancelled.
3. Claims 1, 4-5, 7-10, and 19-22 have been amended.
4. Claims 1-25 are currently pending and have been examined.

Specification Objections

5. The amendment filed 07/08/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities; automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity”.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 10, 19 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's amendment filed on 07/08/2009 contains the limitation "providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities; automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity" is considered new matter since it does not have any support in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 19-21 are rejected under 35 U.S.C § 101. Claiming "Software per se" is non-statutory under 35 USC 101 because it is merely a set instruction without any defined structural

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hardware components. As such, the claim is not limited to statutory subject matter and is therefore non- statutory.

FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES "

REPRESENTING DESCRIPTIVE MATERIAL PER SE OR COMPUTER

PROGRAMS REPRESENTING COMPUTER LISTINGS PER SE

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reifel (US 7,013,288) in view of Kurz (US 6,584,290) and further in view of Barns-Slavin (US 5,995,950).

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11. Regarding Claims 1, 10, 19, and 22: Reifel discloses a method for print fulfillment, comprising the steps of:

- maintaining a print quantity in a server using maintenance code operating on a computer, the print quantity being associated with predetermined economical ship quantities of a recipient (fig 8-9, col 2 lines 5-10 and col 6 lines 20-42);
- accumulating a collection of images received from an originator in the server using collection code operating on a computer, the collection of images being associated with the recipient (figs 8-9);
- providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities using interface code operating on a computer (fig.7B, 8, col 17 lns 9-30);
- automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities using implementation code operating on a computer and automatically delaying printing of the images that are associated with the predetermined economical ship quantities using delaying code operating on a computer until a total number of the images included in the collection of images breaches the print quantity (figs 2-4, col 4 lines 20-30, col 13 lines 33-36, col 16 lines 19-37, col 17 lns 9-30, and claim 11).

Reifel does not explicitly teach determining a print quantity defined by a predetermined economical ship quantity and automatically printing the images when a total number of the images breaches the print quantity.

However, Kurz does teach automatically printing the documents (images) after an indication of a threshold condition (col 7 lines 16-18 and claim 7).

While Barns-Slavin teach determining a print quantity defined by a predetermined economical ship quantity (discounted shipping charges can be determined for number of parcels to be shipped to a consignee; col 1 lns 12-43).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Kurz's and Barns-Slavin teachings in Reifel's "method and system for managing the distribution of images and prints" enabled, for the advantage of ordering a large quantity of prints to be shipped at a reduce price.

12. Regarding Claims 2, 11, 20, and 23: Reifel disclose a method of claim 1, wherein the step of implementing the printing of the image included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of: printing each of the images in the collection of images; and shipping the images to the recipient (figs 8-9, col 13 lines 35-37, col 17 lines 12-16, and col 18 lines 36-48).

13. Regarding Claims 3, 12, 21, and 24: Reifel disclose a method of claim 1, wherein the step of implementing the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of:

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- Transmitting each of the images in the collection of images to a print vendor for printing (col 5 lines 28-30, col 12 lines 17-27, and col 15 lines 55-60)
- Transmitting a ship address associated with the recipient to the print vendor to facilitate shipping of printed ones of the image to the recipient (figs 4, 5, 7A, col 18 lines 26-29, and col 18 lines 36-48).

14. Regarding Claims 4, 13 and 25: Reifel disclose a method of claim 3, further comprising the step of tracking a total number of the images transmitted to the print vendor for printing using tracking code operating on a computer (col 9 lines 32-38, col 12 lines 49-62, and col 16 lines 34-37).

15. Regarding Claims 5 and 14: Reifel disclose a method of claim 1, further comprising the step of implementing the printing of the images included in the collection of images upon receipt of an order for immediate printing of the collection of images from the originator using the collection code operating on a computer (figs 3-5, col 5 lines 45-61, and col 6 lines 37-42).

16. Regarding Claims 6 and 15: Reifel disclose a method of claim 1, wherein the step of accumulating the collection of images received from the originator in the server further comprises the steps of:

- Receiving a number of images from the originator (figs 5 and 8).

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- Adding each of the number of images to the collection of images (figs 5 & 8, and col 6 lines 37-42).
- Determining if the total number of the images included in the collection of images breaches the print quantity after adding each of the number of images to the collection of images (col 16 lines 29-37).

17. Regarding Claims 7 and 16: Reifel disclose a method of claim 1, further comprising the step of acknowledging a receipt of a number of images to the originator using acknowledging code operating on a computer (col 19 lines 42-51).

18. Regarding Claims 8 and 17: Reifel disclose a method of claim 1, further comprising the step of sending a print notification to the originator when the total number of the images included in the collection of images breaches the print quantity using sending code operating on a computer (col 19 lines 42-51).

19. Regarding Claims 9 and 18: Reifel disclose a method of claim 1, further comprising the step of obtaining a payment for the implementation of the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity using payment code operating on a computer (fig 8-9, col 5 lines 35-44, col 11 lines 4-6, col 20 lines 50-57).

Response to Arguments

20. Applicant's arguments have been fully considered but they are not persuasive. In particular the applicant argues that: a) the combination of references do not teach providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities and automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of the images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity. b) rejections under 35 U.S.C § 112, first rejection and submits that all of the claims, as currently written, comply with 35 U.S.C § 112, first paragraph.

In response to a) examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Reifel teaches that a consumer may select the default number of copies to be made of each image, the print sizes, and whether copies of the images should be provided on CD-ROM. providing a form that includes fields to allow the consumer to specify copies of prints should automatically be made for a designated recipient. The consumer can select which images are to be private, which are to be shared, and which are to be public. The consumer can specify that only certain images are to be reproduced, and can specify the type and size of image reproductions on an image-by-image basis. The consumer may elect to receive reprints of selected images with attachments such as advertisements, coupons, promotional message in exchange for receiving the reprints for free or at a discounted rate (col 17 lns 9-30, col 18 lns 19-46, and col 20 lns 29-33). Therefore, Reifel have the

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capability to associate and disassociate images to different categories or groups such as a private group, a public group, a shared group, and a group for selected images to be printed with attachments in exchange for receiving the prints for free or at a discounted rate. Reifel does not appear to explicitly teach associating or disassociating with a predetermined economical ship quantities. However, Barns-Slavin teaches enabling a user to determine the shipping charges for shipping of parcels by a selected carrier wherein discounted shipping charges can be determined for groups of parcels to be shipped to a single consignee, where the group of parcels met certain predetermined requirements (col 1 lns 8-14, col 1 lns 35-40). Reifel does not appear to explicitly teach delaying printing of images until a total number of the images included in the collection of images breaches the print quantity. However, Kurz teaches a system and method for automatically printing documents (images) after an indication of a threshold condition (col 7 lns 17-18). Therefore, the combination of Reifel, Kurz, and Barns_Slavin still meet the scope of the limitation as currently claimed.

In response to b) examiner respectfully disagrees. The examiner has reviewed the specification and specifically the applicant's cited paragraphs [0014], [0016], [0024], and [0034], and figs. 1 & 3-7 which may have support for the claims as written. However, the examiner was not able to find any support for the claims as currently written. The applicant is attempting to equate "print images immediately" to "disassociated with the predetermined economical ship quantities" which is not true. Because disassociating images from the predetermined economical ship quantities does not necessary need to be printed immediately. The disassociated images could be delayed for any other purpose other than predetermined economical ship quantities.

Therefore, it is concluded that applicant does not have support for that feature and is required to cancel the new matter in the next response.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
February 17, 2010

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627